

Appl. No. 10/810,758
Amdt. dated November 30, 2005
Reply to Office Action of August 31, 2005

REMARKS/ARGUMENTS

Claims 25, 26, and 28-34 are amended, and claims 36-53 are cancelled. Claims 25-35 are now pending in the application. Applicants request reconsideration of the application in light of the following remarks.

Claims 36-53 were withdrawn from consideration by the Examiner as being directed to a non-elected invention and are accordingly cancelled by this amendment.

Claims 25, 28-31 were rejected under 35 USC 101 as being directed to non-statutory subject matter. Applicants believe this amendment places the claims within the ambit of statutory subject matter.

Moreover, claim 35 recites "fabricating a probe card in accordance with said probe card design," which produces a tangible product. Claim 35 is therefore without question within the ambit of statutory subject matter.

Claims 25-35 were rejected under 35 USC 103 as unpatentable over US Patent No. 6,578,174 to Zizzo ("Zizzo") in view of US Patent No. 6,701,474 to Cooke et al. ("Cooke"). Applicants respectfully traverse this rejection.

The Examiner has stated that the Applicants' arguments presented previously "have been considered but are moot" in light of this new ground of rejection. Applicants respectfully disagree. As discussed at length in Applicants' previous response, the distinction between a die (an "IC" as discussed in Cooke) and a probe card is significant. Specifically, Zizzo does not mention probe cards at all, but only discloses a method of designing chips by connecting resources via a distributed electronic network (e.g. the Internet). The Examiner notes that Zizzo does not disclose a user inputting parameters describing a wafer to be tested, or receiving a description of a probe card to test the wafer. This point bears emphasis: designing a wafer does not equate to a method of testing the integrity of that wafer, nor does it equate to a method of creating a separate testing device (a probe card). Testing a wafer requires distinct tools, procedures, techniques, and designs, as shown by Cooke.

The Examiner has concluded that the combination of Zizzo, which teaches a system for designing chips, and Cooke, which teaches a method of testing a chip, renders obvious the present invention for designing tools to test a chip. Applicants respectfully disagree and submit that the Applicants' previous discussion of Cooke remains relevant. In particular, Applicants previously stated that "[a] fundamental difference between the claims of the instant application

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and Cooke is as follows: the claims of the instant application are directed to a process of designing and verifying the *probe card*. In contrast, Cooke is concerned with processes for designing and verifying the *die* (referred to as an "IC" in Cooke), including creating patterns of test signals for testing the die." (emphasis added.) The Examiner would take the non-obvious step of applying Zizzo to a process not envisioned or discussed by Cooke.

In light of the foregoing, Applicants would further point out that M.P.E.P. 706.02(j) requires that, to establish a *prima facie* case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings." Applicants are not aware, and the Examiner has not provided, any evidence of such suggestion or motivation to combine the teachings of Zizzo and Cooke with the separate procedures related to a probe card as presented by the instant invention (and as discussed in Applicants' prior communication). Further, § 706.02(j) requires that the prior art references, when combined, "must teach or suggest all the claim limitations." As discussed here, Applicants respectfully submit that the *design or making of* a probe card is not addressed by any language in either Zizzo or Cooke. Because the design or making of a probe card—the core feature of the instant invention—is not disclosed or suggested by the prior art cited by the Examiner, Applicants submit that the cited references do not render the instant invention obvious under 15 USC 103.

Claims 25-35 have been rejected under the judicially created doctrine of double-patenting over claims 1-54 of US Patent No. 6,714,828 B2. Accordingly, Applicant has enclosed a Terminal Disclaimer, with the accompanying fee, to overcome this rejection. Applicants' filing of the Terminal Disclaimer should not be construed as acquiescence to the Examiner's conclusion of obviousness based upon double-patenting.

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In view of the foregoing, Applicants submit that all of the claims are allowable and the application is in condition for allowance. If the Examiner believes that a discussion with Applicants' attorney would be helpful, the Examiner is invited to contact the undersigned at (801) 323-5934.

Respectfully submitted,

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